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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/160,581	09/25/1998	RYUICHI ISHIKAWA	0041-0619-3	6525

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EXAMINER

PRONE, JASON D

ART UNIT PAPER NUMBER

3724

DATE MAILED: 01/30/2004

36

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/160,581

Applicant(s)

ISHIKAWA ET AL.

Examiner

Jason Prone

Art Unit

3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,2,17,18 and 21-25 is/are pending in the application.
- 4a) Of the above claim(s) 1 and 2 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17,18 and 21-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Specification***

1. The specification is objected to under 37 CFR 1.71, as being confusing and difficult to comprehend the invention and compare with prior art. For example, the following items are not understood: It is unclear how the acceleration of the cutting blade is prevented after the blade transits the center of the work piece. See the rejections under 35 USC § 112, first paragraph for more details

Applicant is required to submit an amendment which clarifies the disclosure so that the examiner may make a proper comparison of the invention with the prior art.

Applicant should be careful not to introduce any new matter into the disclosure (i.e., matter which is not supported by the disclosure as originally filed).

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 17-25 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

4. It is unclear how the acceleration of the cutting blade is prevented after the blade transits the center of the work piece. It is uncertain what structure prevents the acceleration. From the specification and the Figures, it is assumed that the blade

Art Unit: 3724

moves at a constant speed, therefore, the acceleration would stop right after the blade first started moving.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 17, 18, and 21-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

On lines 5-6 of claim 17, it is unclear how the acceleration of the cutting blade is prevented after the blade transits the center of the work piece.

In regards to claims 17 and 21, the phrases "moving a cutting blade by drive force", on line 3 of claim 17, "cutting blade is moved by using an optical fiber cutting apparatus", on line 2 of claim 21, and "a cutting blade holder configured to hold and to move the cutting blade", on lines 3-4 of claim 21, are unclear. It is uncertain if the drive force, the optical fiber cutting apparatus, or the cutting blade holder moves the blade.

In regards to claim 17 and 25, the phrases "automatically stopping transmission of said drive force to said cutting blade", on line 7 of claim 17, and "the transmission of said drive force between said motor and said drive force transmission part is automatically stopped", on lines 8-9 of claim 25. It is uncertain if these two phrase are referring to the same "stopping step".

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 3724

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 17, 18, and 21-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Burns.

Burns discloses the invention including moving a cutting blade (20) to transit a center portion of the work piece (Figs. 6-8), preventing acceleration of the cutting blade after the cutting transits the work piece (Fig. 8), a cutting blade holder (42), a work piece supporter (16) configured to support the work piece so as to position it perpendicular to the cutting blade (Fig. 2), that the speed of movement of the cutting blade is constant (Figs. 6-8), a speed reduction device (10) configured to receive and reduce a drive force (Figs. 3 and 4), a drive force transmission device configured to transfer the drive force from the speed reducing device to the cutting blade (Fig. 3), that the drive force is provided by a motor (21), that the speed reducing device comprises a plurality of speed reducing gears (25 and 21) configured to reduce a rotational speed (Fig. 3), and that the drive force transmission device comprises a cam configured to rotate along with the rotation of the plurality of speed reducing gears and a cam follower configured to move in a rectilinear direction along with the rotation of the cam (Column 1 lines 35-38 and Figs. 6-8).

9. It is to be noted that claim 25 has not been rejected over prior art. It may or may not be readable over the prior art but cannot be determined at this time in view of the issues under 35 USC § 112.

***Response to Arguments***

Art Unit: 3724

10. Applicant's arguments filed 21 November 2003 have been fully considered but they are not persuasive. In response that the Burns patent is not believed to have a mechanism for automatically stopping the movement of the arm when cutting is finished. First, a mechanism for automatically stopping the movement of the arm when cutting is finished is not disclosed in the claims only a step of automatically stopping the transmission of the drive force is disclosed. Burns clearly has a mechanism for automatically stopping the movement of the arm when cutting is finished or the blade would keep traveling. The Burns patent clearly shows all steps disclosed in claim 17, 18, and 21-24. It is noted that claim 17 is basically restated in claims 21-24 and does not have a real purpose. It is also noted that the structure of the apparatus must be incorporated into the method steps to overcome the prior art. Therefore, the rejection is valid and will remain.

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Lindley, Koefferlein, Montagnino, Moriya, Akita, Longrod, Miyatsu et al., Sato, and Ishikawa et al.

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

Art Unit: 3724

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Prone whose telephone number is 703-605-4287. The examiner can normally be reached on 7:30-5:00, Mon - (every other) Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on 703-308-1082. In lieu of mailing, it is encouraged that all formal responses be faxed to 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.



JP  
January 23, 2004



Allan N. Shoap  
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